



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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3/26/02

In re application of: Levine

Serial No.: 08/710,645

Group No.: 2611

Filed: Sept. 18, 1996

Examiner: R. Brown

COPY OF PAPERS
ORIGINALLY FILED

For: TELEVISION SYSTEM MODULAR WITH REMOTE CONTROL CODE
DETERMINATION

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RESPONSE TO OFFICE ACTION

Technology Center 2600

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed October 3, 2001, the claims of this reissue application are being resubmitted in unamended form for reconsideration in view of the following remarks.

Claims 1-22 stand rejected under 35 U.S.C. §103(a) over Furrey ('653) in view of Amano ('622). Considering independent claims 1, 11 and 16, the Examiner is correct that Furrey teaches a VCR operative to check to see whether a receiving unit has executed commands that have been transmitted. The Examiner is also correct that Furrey teaches that one of the operations of the associated unit is to detect whether the cable box has been turned on or off, but does not explicitly teach that the energization codes for the associated unit are stored in the VCR. Although Amano teaches the storage of "switch-on" or energization codes for manufacturers in a remote commander, the Examiner draws the conclusion that it would have been obvious to one of ordinary skill in the art to modify Furrey with the feature disclosed in Amano "for the known advantage of a more flexible system which is enabled to control a wider range of associated units." Applicant respectfully disagrees with this conclusion.

In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed modification, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, it is not the goal of Furrey to energize associated units, but rather, to make certain that codes already stored are received. Presumably, if it is determined that VCR is not receiving the appropriate signal from the cable box, it is up to the user to turn the cable box on. The Examiner's attention is directed to column 4, lines 49-54 of Furrey, wherein it is stated that "an electrically-erasable programmable RAM (EEPROM) serves as non-volatile storage with respect to channel data, user-entered channel data and VCR Plus® channel mapping data." This would have been the opportunity for Furrey to indicate the desirability of also storing energization codes, but Furrey did not take this opportunity, because the VCR/cable box combination with respect to the Furrey invention are set up as a unit, and not intended to "learn" the energization code associated with the cable box. This is marked contrast to the instant invention, which is specifically intended (and claimed) for use with equipment from various manufacturers, to initially determine whether an associated unit has been turned on or off such that, from that point on, more specific control functions may be recognized and stored.

Furrey, even in combination with Amano, accordingly does not teach the limitations of Applicant's independent claims, such that the dependent claims are allowable as well. Questions

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regarding this application can be directed to Applicant's below-signed representative at the telephone/facsimile numbers provided.

Respectfully submitted,

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